

8 12.11.03 2661



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 037267/0138

Applicant: Canada NAKAYASU
Title: SYSTEM FOR MONITORING CDMA-TYPE MOBILE TERMINAL
AND METHOD OF DOING THE SAME
Serial No. 09/866,796
Filed: May 30, 2001
Examiner: Unknown
Art Unit: 2661

RECEIVED

DEC 10 2003

Technology Center 2600

RECEIVED

DEC 10 2003

TC 2600

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO-SB08 is a list of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any documents which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

CERTIFICATION

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that item of information A2 listed on the Form PTO SB/08 submitted with this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement. Item of information A1 is a U.S. patent that is a counterpart to item of information A2.

RELEVANCE OF EACH DOCUMENT

A translation of a portion of a Chinese Office Action that issued October 10, 2003 with respect to a counterpart Chinese patent application is provided below.

"The application relates to a system for monitoring a CDMA-type mobile terminal device and a method of doing the same. After examination, the opinions of the Examiner are proposed as follows:

1. Independent claim 1 is objected under Article 22(2) of the Chinese Patent Law

Claim 1 claims a system for monitoring a CDMA-type mobile terminal device. The Reference 1 (CN1219330A) discloses a wireless terminal having digital signal processors that can monitor the operating characteristics of the associated wireless terminals and report those characteristics to a network management computer (see Abstract of the Invention of the Reference 1). Specifically, the Reference 1 discloses following technical features: a wireless communication network comprising base station connected to mobile terminal through radio frequency signal, a network connected to base station through lines, and monitoring device connected to the network, for monitoring mobile communication device, wherein the monitoring being setup by transmitting the operating characteristics of wireless terminal to network management computer (see the Claims and Figures 6, 7 and 8 of the Reference 1). The only difference between the technical solution to be protected by claim 1 and the contents disclosed by Reference 1 exists in expression manner. Two technical solutions are the same one substantively, belong to the same technical field and result in the same technical effects. Thus, claim 1 has no novelty over Reference 1.

The Article 22(2) of the Chinese Patent Law: Novelty means that, before the date of filing, no identical invention or utility model has been publicly disclosed in publications in the country or abroad or has been publicly used or made known to the public by any other means in the country, nor has any other person filed previously with the Patent Administration Department Under the State Council an application which described the identical invention or utility model and was published after the said date of filing.

2. Claims 7 and 8 objected under Article 22(2) of the Chinese Patent Law for the same reason as the claim 1.
3. Some unnecessary brackets should not exist in claims except for the reference signs and other necessary situations (see the Examination Guidance Section 3.2.2, Chapter 2, Part II). The applicant should delete the unnecessary brackets before each step of the claims 1, 6, 13 and 14.

A translation of the Examination Guidance Section 3.2.2, Chapter 2, Part II: the Description should not have brackets except for the reference signs and other necessary situations.

4. Each portion of the Specification should has its subtitle, this point does not meet the requirement of Rule 18(2) of the Implementing Regulations of the Chinese Patent Law.

In summary, due to the reasons mentioned above, this application could not be granted a patent at present. The applicant should amend the claims following the requirements as described above. It should be noted that the amendment to the application could not go beyond the scope of the disclosure contained in the initial description and claims. Otherwise, the application would be rejected."

Applicant's statements regarding the Chinese Office Action is based on a partial translation that Applicant's representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, which is asserted in the Chinese Office Action.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form-SB08 be returned in accordance with MPEP §609.

Respectfully submitted,

December 9, 2003
Date

Phillip J. Articola
Phillip J. Articola
Registration No. 38,819

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Under the Paperwork Reduction Act of 1995, no person shall be required to provide information on this form unless it displays the following number.

Substitute for form 1449B/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

Date Submitted: December 9, 2003

(use as many sheets as necessary)

| | | | |
|-------|---|----|---|
| Sheet | 1 | of | 1 |
|-------|---|----|---|

Complete if Known

| | |
|-------------------------------|-----------------|
| Application Number | 09/866,796 |
| Filing Date | 05/30/2001 |
| First Named Inventor | Kanada NAKAYASU |
| Group Art Unit | 2661 |
| Examiner Name | Unknown |
| Attorney Docket Number | 037267-0138 |

U.S. PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document MM-DD-YYYY | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------|-----------------------|----------------------|-----------------------------------|---|--|---|
| | | Number | Kind Code ² (if known) | | | |
| | A1 | 5,819,177 | | VUCETIC et al. | 10/06/1998 | |
| | | | | | | |
| | | | | | | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | | | Name of Patentee or Applicant of Cited Documents | Date of Publication of Cited Document MM-DD-YYYY | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
|--------------------|-----------------------|-------------------------|---------------------|--------------------------------------|--|---|---|----------------|
| | | Office ³ | Number ⁴ | Kind Code ⁵ (if known) | | | | |
| | A2 | CN | 1219330A | | 06/09/1999 | | X | |
| | | | | | | | | |

NON PATENT LITERATURE DOCUMENTS

[illegible]

RECEIVED
DEC 10 2003
Technology Center 2600

Examiner
Signature

Date
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.